**GUCCIO GUCCI S.P.A**

**v.**

**SUKHDAV SINGH JAL SINGH**

HIGH COURT, SINGAPORE
CHAN SEK KEONG J
[SUIT NOS. 584, 585 AND 586 OF 1990]
19 NOVEMBER 1991

***CIVIL PROCEDURE:*** *Infringement of trade mark - Application for discovery from defendant - Defendant claiming privilege against self-incrimination - Principles applicable - Test to be applied - Undertaking by plaintiffs not to use information in criminal proceedings - Effect of - Power of Court - Statutory immunity - Trade Marks Act, s. 73 - Evidence Act, ss. 2, 134.*

The plaintiffs were claiming, *inter alia,* injunctive relief and damages against the defendant for infringement of their respective registered trade marks. The plaintiffs had earlier caused search warrants to be issued against the defendant, which resulted in the plaintiffs seizing hundreds of bottles of perfumes bearing famous brands.

Pursuant to these seizures, the plaintiffs have commenced private prosecutions against the defendant for offences under s. 73 of the Trade Marks Act (the Act).

In these proceedings, the plaintiffs seek summary judgment, including two prayers for discovery. In their statements of claim, the plaintiffs stated that they were unable to particularise all the infringing acts of the defendant until after discovery or interrogatories but will claim to recover in respect of such claims. The defendant had consented to all the orders except the two in relation to discovery.

The defendant resists these 2 prayers on the ground that the Court cannot compel him to give information which tends to or will incriminate himself and claims the privilege against self-incrimination in respect of the unparticularised and unproved acts.

**Held:**

**[1]** The undertaking of the plaintiffs not to prefer new criminal charges against the defendant under s. 73 of the Act in respect of any infringement that may be disclosed and not to use the evidence disclosed in the pending prosecutions was not good enough.

**[2]** The Statutory immunity conferred by s. 134 of the Evidence Act offers no protection to the defendant here as he is not a witness or in the position of a witness.

**[3]** Therefore having regard to s. 134 read with s. 2 of the Evidence Act and the *RANK FILM* decision, the Court has no power in the circumstances to impose a condition that such evidence shall not be admissible in criminal proceedings against the defendant.

**[4]** The offence with which the defendant could be charged was a grave offence and it was likely that he would be prosecuted for offences under s. 73 as the Public Prosecutor is free to prosecute the defendant for the unparticularised acts of infringement, even though he has not prosecuted them for the particularised offences.

**[5]** It is clear that the defendant consented to judgment only in relation to those infringing acts that were particularised.

**[6]** The privilege against self-incrimination applies as much to pre-trial discovery as to post-judgment discovery and as such there will be no order on the prayers for discovery.

*[Plaintiffs' order for discovery dismissed.]*

**Cases referred to:**
*Draper v. Hubert Trist [1935] 53 RPC 66* ***(cit)***
*The Leather Cloth Co. (Ltd.) v. Hieaxhdiwls [1863] 1 H & M 295* ***(cit)***
*Powell v. The Birmingham Vinegar Brewery Co. Ltd. [1897] 14 RPC 1* ***(cit)***
*Murray v. Clayton [1872] 15 Eq 115* ***(cit)***
*Saccharin Co. v. Chemicals & Drugs Co. [1990] 2 Ch 556* ***(cit)***
*Riedel-De-Haen Ag v. Liew Keng Pang [1989] 2 MLJ 400* ***(foll)***
*Adams v. Lloyd [1858] 3 H & N 351* ***(foll)***
*Triplex Safety Glass Co. Ltd. v. Lancegaye Safety Glass (1934) Ltd. [1939] All ER Ann 613* ***(foll)***
*Sociedade Nacional De Conbustiveis De Angola Uee v. Landquist [1990] 1 All ER 283* ***(foll)***
*Thorn Emi Video Programmes Ltd. v. Kitching & Busby [1984] FSR 343 (New Zealand)* ***(dist)***
*Authors Workshop v. Bileru [1989] 16 IPR 661 (Australia)* ***(dist)***
*Ocli Optical Coatings Ltd. v. Spectron Optical Coatings Ltd. [1980] FSR (UK)* ***(dist)***
*Snugkoat Ltd. v. Chaudhry [1980] RSR 286 (UK)* ***(cit)***
*Rank Film Distributors Ltd. v. Video Information Centre [1981] 2 All ER 76* ***(dist)***
*Ewing v. Osbaldiston [1834] 6 Sim 608* ***(cons)***
*Ullmann v. US 350 [1955] US 422* ***(cit)***

**Legislation referred to:**
Copyright Act 1962 [NZ'], s. 28
Crimes Act 1961 [NZ], s. 257
Copyright Act 1956 [UK], s. 21
Criminal Justice Act 1988 [UK], s. 77
Evidence Act [Sing], s. 134
Trade Descriptions Act 1968 [UK], s. 1
Trade Marks Act [Sing], s. 73
Theft Act 1956 [UK], s. 31

*For the plaintiffs - Steven Seah (Toh Wee Jin with him); M/s. Drew & Napier*
*For the defendant - Gopalan; M/s. Raja & Partners*

[**Editor's Note:** The following cases were heard together at this High Court sitting:

1. *L'Oreal v. Sukhdav Singh s/o Jal Singh* Suit No. 585/90
2. *Parfums Guy Laroche v. Sukhdav Singh s/o Jal Singh*, Suit No. 586/90.]

**JUDGMENT**

**Chan Sek Keong J:**

In each of these 3 actions, the plaintiffs claimed, *inter alia*, injunctive relief and damages against the defendant for infringement of their respective registered trade marks.

Prior to the commencement of these actions, the plaintiffs caused to be issued against the defendant search warrants under the Criminal Procedure Code, which upon execution resulted in the plaintiffs seizing hundreds of bottles of perfumes bearing the relevant trade marks and other paraphernalia for their manufacture, bottling, and packing. The brand names involved were *Christian Dior, Yves St Laurent, Polo, Gucci, Anais Anais, Charlie* and *Giorgio*. Pursuant to these seizures, the plaintiffs have commenced private prosecutions against the defendant for offences under s. 73 of the Trade Marks Act.

The 3 applications before me are for summary judgment against the defendant for the following orders: (1) a permanent injunction to restrain the defendant from further infringements (2) the delivery up of all infringing articles (3) the defendants to disclose information relating to past infringements by means of (4) an affidavit (5) leave to the plaintiffs to destroy all infringing articles seized (6) an inquiry as to damages, and (7) costs. At the first hearing before me on 2 September 1991 the defendant consented to, and judgment was given in respect of prayers (1), (2), (5),(6) and (7), such costs to be fixed by the Registrar at the appropriate scale of fees by reference to the amount of damages so found in the inquiry. Prayers (3) and (4) are for discovery. The defendant resists these two prayers on the ground that the Court cannot compel him to give information which tends to or will incriminate himself. In an ordinary case where such infringing acts do not expose the infringer to prosecution for criminal offences relating to or arising from such acts, it is established law that the successful plaintiff is entitled to post-judgment discovery as a means of proving his damages: see *Draper v. Hubert Trist* [1935] 53 RPC 66; *The Leather Cloth Company (Ltd) v. Hirschfield* [1863] 1 H & M 295, *Powell v. The Birmingham Vinegar Brewery Co. Ltd.* [1897] 14 RPC 1, *Murray v. Clayton* [1872] 15 Eq 115 and *Saccharin Corp. v. Chemicals & Drugs Co.* [1900] 2 Ch 556.

Prayers (3) and (4) read as follows:

> 3. The defendant do disclose forthwith to the plaintiffs' solicitors the following:
>
> (a) The names and addresses of all persons, firms, companies or otherwise to whom the defendant had sold, distributed, supplied or otherwise disposed of the counterfeit 'Gucci' perfume and perfumery prior to the issue of the writ in this action.
>
> (b) The full details of the date and quantities of each sale, distribution, supply or disposal referred to in (a).
>
> (c) The full details of the value and description of each counterfeit item in each sale, distribution, supply or disposal referred to in (a).
>
> (d) All the documents including invoices and receipts which are or have been at any time in his possession, custody or power relating to such sale, distribution, supply or disposal referred to in a).
>
> 4. Within seven (7) days of the service on him of the order to be made herein the defendant do make and serve on the plaintiffs' solicitors an affidavit setting out all the information to be disclosed pursuant to this Order and exhibiting thereto all relevant documents and/or articles.

The information sought under prayer 3 forms part of each of the plaintiffs' claim for damages for infringement. Paragraph 3 of each of the statements of claim refers to past acts of infringement, *viz.*, manufacturing, bottling, having in possession for sale, selling/and or offering for sale in the course of trade perfume bearing the plaintiffs' trade mark but which are not the perfume manufactured by the plaintiffs or with their consent. Sub-paras. (i) to (iv) of the particulars refer to acts of infringement evidenced by the possession of the bottles and paraphernalia that were seized under the search warrant. Sub-para. (v) states that the plaintiffs:

> are unable to particularise all the infringing acts of the defendant until after discovery or interrogatories but will claim to recover in respect of such claims.

The plaintiffs' claims for damages are therefore not limited to the acts of infringement particularised in the particulars but include those which are to be discovered.

Although the plaintiffs are seeking discovery to augment their damages, they are effectively seeking evidence to uncover past acts of infringement. Having regard to the terms of s. 73 of the Trade Marks Act, which make infringement of a trade mark in the manner prescribed

therein an offence, it cannot be disputed that the past acts of infringement of the defendant, if uncovered, would constitute offences under that section. The reason is that the bases of the civil action are substantially the same as those of the s. 73 offence. It is therefore plain that the plaintiffs are seeking an order of Court which, when obeyed, will have the effect of compelling the defendant to incriminate himself in relation to offences arising from the past acts of infringement. Not surprisingly, the defendant has claimed the privilege against self-incrimination in an affidavit filed in each of the 3 applications. He does not claim the privilege in respect of the particularised acts as he has already been charged under s. 73 of the Trade Marks Act in relation to such acts, and to which he has also consented to judgment. He claims it in respect of the unparticularised, and therefore unproved, acts.

In *Riedel-De-Haen AG v. Liew Keng Pang* [1989] 2 MLJ 400, I held that the privilege against self-incrimination, being part of the common law applied with full force in Singapore to pre-trial discovery by a plaintiff in an action for infringements of copyright, and that the privilege was not abrogated or affected by s. 134 of the Evidence Act. Counsel for the plaintiffs accepts the correctness of the decision, but does not accept that the defendant in these 3 actions is entitled to claim the privilege. I shall examine his arguments later. Where the privilege is claimed and there is a basis for claiming it, "it is the paramount duty of the Court to uphold it" (per du Parcq LJ in *Triplex Glass Co.*, at p. 617. However, the Judge must consider whether it is a *bona fide* claim. The mere assertion by a party that he may or will in criminate himself is not sufficient. The Judge should be certain that the authority of the Court is not being "trifled with": see Pollock CB (at p. 362) in *Adams v. Lloyd* [1858] 3 H & N 351, *Triplex Safety Glass Co. v. Lancegaye Safety Glass (1934) Ltd.* [1939] All ER Ann 613, at p. 617, and *Sociedade Nacional De Conbustiveis De Angola Uee v. Landquist* [1990] 1 All ER 283, at p. 293. In these 3 actions, there is no doubt that the defendant has a basis for claiming it.

However, Counsel for the plaintiffs contends that, unlike the situation in *Riedel-De-Haen* where Counsel for the plaintiff conceded that there was a serious risk of the defendant being exposed to a prosecution under the Trade Marks Act and the Consumer Protection (Trade Descriptions and Safety Requirements) Act, the defendant in these 3 actions is not likely to be exposed to further criminal prosecutions for the past unparticularised acts of infringement. The test is whether there is a real or appreciable risk of the defendant being prosecuted for such acts, if disclosed. Counsel for the plaintiffs says that the risk is remote for the following reasons:

(1) the plaintiffs will give an undertaking not to prosecute the defendant with respect to any past infringing acts disclosed by him or to use the information in the pending criminal proceedings against him;

(2) the Public Prosecutor did not commence criminal proceedings against the defendant, as a result of which the plaintiffs had to obtain the requisite fiats from him to do so ;

(3) there is no real likelihood of the Public Prosecutor doing so with respect to the undiscovered acts of infringement when he has not done so in respect of the particularised acts. He relies on the following authorities: *Thorn EMI Video Programmes Ltd. v. Kitching & Busby* [1984] FSR 343 (New Zealand), *Authors Workshop v. Bileru* [1989] 16 IPR 661 (Australia), *Ocli Optical Coatings Ltd. v. Spectron Optical Coatings Ltd.* [1980] FSR (UK), *Snugkoat Ltd. v. Chaudhry* [1980] FSR 286 (UK), *Re O* [1990] Times LR 751.

All the decisions relied upon by Counsel for the plaintiffs can be distinguished. In each of them, the Court either found as a fact that there was no real or appreciable risk or imposed conditions against disclosure which eliminated any risk of prosecution. It is useful to examine some of them if only to highlight what they actually decided. I refer first to the decision of Davison CJ in *Thorn EMI* as it has often been cited to me in applications for pre-judgment discovery as a precedent for granting such discovery notwithstanding the plea of privilege against self-incrimination. In that case, the action was based on infringement of copyright. K and B relied on the privilege to resist pre-trial discovery. They contended that the information, if given, would expose them to prosecution for offences under s. 28 of the Copyright Act 1962 and/or for conspiracy to defraud under s. 257 of the Crimes Act 1961. Davison CJ held that the privilege was part of the common law in New Zealand but that (1) in relation to s. 28, the punishment was trivial (following *Rank Film Distributors Ltd. v. Video Information Centre* [1981] 2 All ER 76), and (2) in relation to conspiracy, that, since there had never been a prosecution for conspiracy to defraud based on copyright infringement in New Zealand, there was no "realistic chance" of the defendants facing such a charge (following *Ocli Optical* and *Snugkoat*). However , on appeal (see [1984] 2 IPR 304), one member of the Court of Appeal, Somers J, disagreed with the finding on the absence of realistic chance, whilst the other 2 members, Cooke and Bisson JJ, decided that Davison CJ applied the correct test but did not unequivocally uphold the finding. The appeal was dismissed on a ground which I shall refer to later.

In *Ocli Optical*, the Court of Appeal held that there was no substantial risk of the defendants being prosecuted under s. 21 of the Copyright Act 1956, there being no evidence of any such prosecution for that offence having been conducted, but that there was a risk of prosecution under the Theft Act 1956. However, the Court went on to hold that that risk was irrelevant as s. 31 thereof provided that no person should be excused, by reason of the fact that to do so might incriminate the person in respect of an offence under the Theft Act, from answering any questions put to him in proceedings to recover property, or to account for any property or dealings in property.

*Ocli Optical* was decided after the Court of Appeal's decision but before the House of Lords' decision in *Rank Film.* In *Snugkoat,* Graham J thought that the two Court of Appeal decisions were difficult to reconcile. He held that:

> it is a matter of degree in each case as to how much weight must be given to the likelihood or otherwise of criminal proceedings in fact being brought having regard to the likely results of the making of that particular Anton Piller order.

He suggested that the Court should "exercise its discretion along the lines of common sense and to do justice". He granted the order for discovery subject to the undertaking of the plaintiffs not to initiate any criminal proceedings under s. 1 of the Trade Descriptions Act 1968, although he was of the view that the penalty thereunder, being about £400, was not trivial.

The House of Lords in *Rank Film* held that the maximum fine of £50 for an offence under s. 21 of the Copyright Act was too trivial to give effect to the claim against self-incrimination. In consequence, they also held that the offence of conspiracy to commit the said offence was also too trivial since the penalty was the same. However, they held that a charge based on the common law conspiracy to defraud was serious as the penalties were much heavier, and because the much heavier penalties made it more likely that charges for that offence would be brought: (see p. 81a, ibid). Lord Wilberforce said that a charge of conspiracy to

defraud, so far from being as it sometimes was, a contrived addition to other charges, was there, an appropriate and exact description of what was being done by 3 of the respondents. He said that the risk was not contrived, or fanciful or imagined as there one of them had already been charged for conspiracy to defraud. Similarly, Lord Fraser of Tulleybelton also agreed that the risk of those who manufactured illicit films being prosecuted for conspiracy to defraud was "by no means remote or fanciful" (at p. 84a).

In *Authors Workshop*, Lockhart J accepted that the privilege against self-incrimination was a part of the common law in Australia, but held that there was no evidence before him to sustain such a claim and he gave leave to the defendant to file affidavits to support the claim.

In the case of *Re O*, the application was for disclosure of the assets of the accused made in connection with a restraint order under the Criminal Justice Act 1988. The jurisdiction to make restraint orders under the Drug Trafficking Offences Act 1968 was mirrored by the fact that under the Criminal Justice Act and a decision in relation to one Act would apply equally to the other. The 1988 Act contained no provisions expressly empowering the High Court to make any such order. The Court of Appeal held that, although the 1988 Act did not abrogate the privilege against self-incrimination, the Act must have intended the High Court to have the power to render effective a restraint order under s. 77 of the 1988 Act. To do that and to ensure that there was no justification for the accused to plead the privilege, the Court ordered that:

> No disclosure made in compliance with the order of the Court shall be used in evidence in the prosecution of an offence alleged to have been committed by the person required to make disclosure or by any spouse of that person.

The Court was of the view that the undertaking of the Crown Prosecution Service was not the appropriate course to take.

In these 3 actions, the main protection that the defendant has is the undertaking of the plaintiffs not to prefer new criminal charges against the defendant under s. 73 of the Trade Marks Act in respect of any acts of infringement that may be disclosed and not to use the evidence disclosed in the pending prosecutions. Their undertaking is not good enough: see *Rank Film* and *Re O*. The fact that the Public Prosecutor has not prosecuted the defendant for any offences in connection with the trade mark infringements does not mean that there is no likelihood of such prosecution being commenced. In *Triplex Safety Glass Co. Ltd. v. Lancegaye Glass (1934) Ltd.* [1939] All ER ANN 613, du Parcq LJ said, at p. 618:

> The "danger" of the existence of which the Court must be satisfied is, to quote again the words of Field J, in *Lamb v. Munster*, at p.111:
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> > ... the peril and possibility of being convicted as a criminal.
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> In *R v. Boyes*, it was held that no such danger existed, because the witness had been pardoned by the Crown for the part which he had taken in the transaction alleged to be criminal. He professed to fear, notwithstanding the pardon, that he might be impeached by the House of Commons, a supposition which the Court held to be "simply ridiculous."

The principle there laid down, at p. 330, was:

> ... that a merely remote and naked possibility, out of the ordinary course of the law and such as no reasonable man would be affected by, should not be suffered to obstruct the administration of justice.

> That is the only case to which our attention was directed in which a witness was compelled to admit in terms the commission of a criminal offence, and the ground of the decision was that "in the ordinary course of the law" it had become not merely improbable, but impossible, that the witness should ever be convicted of that offences. It does not seem ever to have been held that a man may be compelled to answer a question directed to procuring his confession of a criminal act merely on the ground that, in the particular circumstances of the case, and on a balance or probabilities, it is unlikely that he will be prosecuted. Cases may, of course, arise in which the Court is satisfied that no reasonable man could possibly be apprehensive of a prosecution as, for instance, where the offence is trivial, or was committed many years ago and then it may be that the Judge, even if he were not prepared to go to the length of imputing mala fides to the witness, might insist upon an answer. Much must be left to the discretion of the Judge, who will not usually be likely to take this course unless he thinks that there is a good reason to doubt the witness's good faith. As a general rule, it is true to say that any admission of a criminal offence, of which the witness has not hitherto been convicted, must tend to criminate him within the meaning of the rule.

In the *Thorn EMI* case, Cooke J at p. 315 said:

> Experience suggests that neither the police nor any other persons are likely to prosecute; but mere improbability has never been treated as tantamount to no real risk.

In that case, Cooke J (with whom Bisson J agreed) decided to eliminate the risk of prosecution by holding, firstly, that such evidence would not be admissible in criminal proceedings against the defendant, and secondly, by putting the plaintiff on terms that he would not, either or indirectly use the information or make the same available to the police. The Court of Appeal of New Zealand anticipated the English Court of Appeal in *Re O* in imposing a condition to exclude such evidence from being used in criminal prosecutions.

I should interpose here to observe that in Singapore, s. 134 of the Evidence Act confers statutory immunity to a witness from prosecution for **any** offence (other than that of giving false evidence) in connection with or in respect of any answers he may give to questions asked of him in the witness box. In return for that immunity, the witness is compellable to answer any questions the answers to which may criminate him. This provision offers no protection to the defendant in these 3 cases as he is not a witness or in the position of a witness. Having regard to s. 134 of the Evidence Act, read with s. 2 thereof and the *Rank Film* decision, I do not think that this Court has the power, in the circumstances of this case, to impose a condition that such evidence shall not be admissible in criminal proceedings against the defendant.

None of the matters sufficient to lift the privilege against self-incrimination is present in these 3 cases. With regard to the gravity of the offence, this criterion is satisfied. The offence under s. 73 of the Trade Marks Act of having in one's possession for sale or for any purpose or trade or manufacture, any goods or thing to which a counterfeit trade mark is applied or to which a registered trade mark is falsely applied is punishable with a fine of $10,000 for each goods or thing, subject to a limit of $100,000 or to a term of imprisonment not exceeding 5 years or both. It is not a petty offence.

As to the real likelihood of the defendant being prosecuted for the offences under s. 73 of the Trade Marks Act, no one can say that the likelihood is fanciful nor remote, since the Public Prosecutor is free to prosecute the defendant for the unparticularised acts of infringements, even though he has not prosecuted them for the particularised offences.

Counsel for the plaintiffs has also contended that the defendant, having consented to judgment, is not entitled to claim the privilege against self-incrimination, as in doing so he has incriminated himself. He relied on an old decision, *viz., Ewing v. Osbaldiston* [1834] 6 Sim 608. In this case, the bill was filed to have accounts taken of a partnership between E and O in the Surrey Theatre. The defence made by the answer was that the partnership was illegal. O did not refuse to answer any of the allegations of the bill but stated circumstances sufficient to show that the parties had incurred penalties imposed by 10 Geo. 2, c. 28. E moved that O might be ordered to produce certain books and other documents referred to answer. The motion was resisted that the Court would not compel a defendant to make discovery which would subject him to penalties. Shadwell VC held that as O had made admissions in his answer, which clearly showed that he had incurred the penalties of the Act, "and consequently that he could not be damnified by a production of the documents." In my view, this case is only an illustration of waiver. A defendant may waive the privilege, and he does so if he answers any question without claiming the privilege. In that case, the discovery ordered was confined to documents directly connected with the admissions. In these 3 actions, the defendant has merely consented to judgment. Nothing in this suggests that his intention was to consent to judgment on the plaintiffs' claim other then in respect to those infringing acts that were particularised. He made his position clear by filing an affidavit to claim the privilege expressly before he consented to judgment.

The operation of the privilege against self-incrimination is unavoidable in a case where, as here, the bases for civil liability are the same as those for criminal liability. The plaintiffs say that they are more interested in recovering damages from the defendant than further prosecuting them or putting them in a position of being further prosecuted. Be that as it may, that is not a sufficient reason to deny the defendant his right to plead the privilege, which in the United States is regarded as "one of the great landmarks in man's struggle to make himself civilized." (Erwin N Griswold, *The Fifth Amendment Today* (Cambridge, Mass, 1955), quoted by Frankfurter J. in *Ullmann v. US* 350 [1955] US 422 at 426.) In my view, as the law stands, the privilege applies as much to pre-trial discovery as to post-judgment discovery.

For the above reasons, I make no order on prayers (3) and (4).

Also found at [1992] 1 CLJ 278